UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/170,656	10/14/1998	SURESH JEYACHANDRAN	35.C13009	7028

5514	7590	06/10/2004	EXAMINER

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EXAMINER
LEE, TOMMY D

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/170,656	JEYACHANDRAN ET AL.
	Examiner	Art Unit
	Thomas D. Lee	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 March 2004</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,23,24,27-30,32,33 and 36-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21,23,24,27-30,32,33 and 36-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This Office action is responsive to applicant's AMENDMENT, filed March 26,

2004. Claims 1-21, 23, 24, 27-30, 32, 33 and 36-38 are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

4.   Claims 1-21, 23, 24, 27-30, 32, 33 and 36-38 are rejected under 35 U.S.C.

103(a) as being unpatentable over U.S. Patent 5,291,302 (Gordon et al.) in view of U.S.

Patent 6,043,904 (Nickerson).

       Regarding apparatus claims 1, 4 and 5; and corresponding method claims 10,13

and 14, Gordon et al. disclose an information processing apparatus comprising

identification name designation means for designating by a user (subscriber places call

to destination via SAFF system, read column 8, lines 4-16; originator and destination

telephone numbers transmitted to destination SAFF in response to call, read column 8,

lines 36-44) an identification name (including at least one of an information name, an

information transmitter name, and an information sender name) related to object

information (originating machine's identification, destination machine's telephone

number stored, read column 7, lines 4-13); process designation means for designating

by the user (user prompted to select desired choices by pressing particular numbers on

keypad, read column 9, lines 47-63) a process (including at least one of reception, of

transmission, and of printing) for said object information (fax message delivered to

destination machine, read column 7, lines 15-20); and detection means for detecting

that the designated process is performed on the object information related to the

designated identification name (upon successful delivery, "delivery record" created and

sent back to the originating machine as a fax message, read column 9, lines 1-15).

Gordon et al. do not disclose setup means for setting up by the user in advance

of performing the process, a command to be executed when the process designated by

said process designation means is performed on the object information related to the

identification name designated by said identification name designation means; or

execution means for executing the command set up by said setup means when said

detection means detects that the designated process is performed on the object

information related to the designated identification name. Nickerson discloses a method

for communicating job status information, wherein prior to transmission of a document a

user inputs information regarding delivery of job confirmation information to a remote

location (column 9, line 45 – column 10, line 7). Upon execution of transmission of the

document, it is determined whether remote confirmation is required, and the remote

confirmation is performed according to the determination (column 9, lines 1-33; column

10, lines 35-62). Nickerson recognized that it is sometimes desirable to transmit a

confirmation report to a location remote from the location where a document is

transmitted, in the case where the document's originator is off-site relative to the

transmission job originating station (column 2, lines 15-28). Gordon et al. do not

disclose a capability for transmitting confirmation reports to locations remote from the

originating source, and thus it would have been obvious for one of ordinary skill in the

art to modify the teaching of Gordon et al. by providing a feature allowing for

transmission of confirmation reports to remote locations, as disclosed by Nickerson.

Regarding apparatus claims 2 and 9; and corresponding method claims 11 and

18, the facsimile apparatus disclosed in Nickerson does not appear to provide, in

combination, time limit setup means for setting a time limit; and inhibition means for

inhibiting said execution means for executing a command when the time limit set by

said time limit setup means has expired; or management means for deleting a

command set by said setup means when the time limit sat by said time limit setup

means has expired (Gordon et al. do not disclose setup means or execution means as

recited in the claims, and thus do not disclose inhibition means for inhibiting said

execution means or management means for deleting a command from setup means).

However, it is well known in the art to provide a time limit for entering a command for

performing a process, and for inhibiting or deleting the process when that time limit is reached, so that a user need not input a specific command if he or she decides to abort the process. It would have been obvious to one of ordinary skill in the art that such a limitation would be advantageous for operation of the facsimile apparatus disclosed by Nickerson, for if no time limit were set for entering remote location information in the process described in Nickerson (column 9, line 61 – column 10, line 20), then the facsimile apparatus would not be able to conclude the current transmission job if a user changes his or her mind and decides not to have a confirmation report transmitted to a remote location, without entering a specific command. Therefore, it would have been obvious for one of ordinary skill in the art to provide a time-out feature and management of a setup process responsive to the time-out feature, in the combined teaching of Gordon et al. and Nickerson.

Regarding apparatus claim 3 and corresponding method claim 12, Gordon et al. further comprises status designation means for designating the status of said apparatus; and permission means for permitting said execution means to execute a command when the status designated by said status designation means is established (when the status of the apparatus allows for successful reception of fax message, a delivery record is created, as mentioned above); and management means for deleting a command set by said setup means when the time limit set by said time limit setup means has expired (message and report retransmitted back to originator, then erased, read column 10, lines 9-13)..

Regarding apparatus claims 6-8 and corresponding method claims 15-17,

Nickerson further provides a command for issuing a notification that said designation

process has been completed (confirmation sheet issued (column 9, lines 8-33)), and a

command for performing a further process related to the object information, including at

least one of the printing or of the holding of the object information (job is either

developed at the printing system or transmitted to the printing system (column 11, lines

21-25)).

As for a storage medium which stores a program for performing the method

steps as recited in claim 19, Gordon et al. provide software control as disclosed at

column 19, beginning from line 22. It would have been obvious to providing the setup

and execution steps of Nickerson (see above rejection of claims 1 and 10) in the

program disclosed in Gordon et al., so that a confirmation report may be sent to a

remote location according to setup procedures provided in Nickerson.

Apparatus claims 20, 21, 23, 27; and corresponding method claims 29, 30, 32

and 36, are similar to respective apparatus claims 1, 2, 5, 8; and method claims 10, 11,

14 and 17, but more broadly recite processes for object information and a command to

be executed as first and second processes, respectively. In the cited prior art, the first

and second processes read on Gordon et al.'s fax message delivery and Nickerson's

information regarding delivery of job confirmation information to a remote location, as

set forth above. Therefore, claims 20, 21, 23, 27, 29, 30, 32 and 36 are rejected for the

reasons set forth above with respect to claims 1, 2, 5, 8, 10, 11, 14 and 17.

Regarding apparatus claim 24 and corresponding method claim 33, Gordon et al.

further disclose a designation of at least one of a user name, of an apparatus, and of a

process name as an attribute for the specific process (originating machine's

identification, destination machine's telephone number stored, read column 7, lines 4-

13).

Regarding apparatus claim 28 and corresponding method claim 37, Gordon et al.

further disclose a capability of executing at least one of reading and printing of

information (reports accumulated and delivered as fax document, read column 10, lines

18-35).

As for a storage medium which stores a program for performing the method

steps as recited in claim 38, Gordon et al. provide software control as disclosed at

column 19, beginning from line 22. It would have been obvious to providing the setup

and execution steps of Nickerson (see above rejection of claims 1, 10, 20 and 29) in the

program disclosed in Gordon et al., so that a confirmation report may be sent to a

remote location according to setup procedures provided in Nickerson.

Response to Arguments

5.   Applicant's arguments filed in response to the prior rejection of the above claims

have been fully considered but they are not persuasive. In response to the prior

rejection, applicant amended independent claims 1, 10, 19, 20, 29 and 38 to further

recite set-up of a command or a second process by a user in advance of performing a

process for object information or a first process, and execution of the command or

second process according to the set-up, and asserts that Gordon et al. do not disclose

this limitation (see pages 13-17 of AMENDMENT). While it is agreed that Gordon et al. do not disclose the newly recited limitation, Nickerson, as mentioned above, discloses a method for communicating job status information, wherein prior to transmission of a document a user inputs information regarding delivery of job confirmation information to a remote location (column 9, line 45 – column 10, line 7). Upon execution of transmission of the document, it is determined whether remote confirmation is required, and the remote confirmation is performed according to the determination (column 9, lines 1-33; column 10, lines 35-62). Nickerson recognized that it is sometimes desirable to transmit a confirmation report to a location remote from the location where a document is transmitted, in the case where the document's originator is off-site relative to the transmission job originating station (column 2, lines 15-28). Gordon et al. do not disclose a capability for transmitting confirmation reports to locations remote from the originating source, and thus it would have been obvious for one of ordinary skill in the art to modify the teaching of Gordon et al. by providing a feature allowing for transmission of confirmation reports to remote locations, as disclosed by Nickerson. Accordingly, applicant's assertion that the claims are allowable is not deemed persuasive.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
June 7, 2004